

SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed December 28, 2005. No claims are amended, and claims 1-22 remain pending in the application. Applicant respectfully requests reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

Rejections Under 35 U.S.C. § 103

The Examiner rejected all claims in the application under 35 U.S.C. § 103(a) as obvious in view of, and therefore unpatentable over various combinations of U.S. Patent No. 5,727,109 to Pan *et al.* (“Pan”); U.S. Patent No. 6,178,044 to Li *et al.* (“Li”); and Applicant’s allegedly admitted prior art. Specifically, the Examiner rejected claims 1, 2, 4, 9-11, 13, 17, and 22 over *Pan*; rejected claims 3, 12, and 21 over *Pan* in view of *Li*; and rejected claims 5-8, 14-16, and 18-20 over *Pan* in view of Applicant’s allegedly admitted prior art. Applicant respectfully traverses the Examiner’s rejections.

Claim 1 recites an optical isolator combination including an input, an output, and a phase retardation plate positioned at the input, wherein the phase retardation plate “is the first polarization-modifying component encountered by an optical signal entering through the input.” The Examiner concedes that *Pan* does not disclose that the phase retardation plate is the first polarization-modifying component encountered by the optical signal. Nonetheless the Examiner, citing *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to place a phase retardation plate as the first component of an optical isolator, since it has been held that rearranging parts of an invention involves only routine skill in the art.

Applicant respectfully disagree. That a worker in the art could rearrange the parts of the reference device to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of applicant's specification, to make the necessary changes in the reference device. *See MPEP § 2144.04 (VI)(C); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).* In this case, *Pan* can provide no motivation for re-arranging its parts because it teaches away from such a re-arrangement.

Pan discloses an optical attenuator with low polarization mode dispersion. The attenuator of *Pan* uses a first polarizer 12 to split an input signal into a pair of polarization modes. The purpose of the compensator plate in *Pan* is to equalize the optical paths of the two polarization modes exiting the first polarizer 12 (col. 4, lines 42-52). Since the compensator plate is used to equalize two optical paths, it logically follows that in *Pan* the compensator plate must always come after the incoming signal has already been split into two polarization modes; in other words, the compensator plate must always come after the polarizer 12, never before. Figures 5A-5C and 6 support this conclusion—none of these figures shows the compensation plate 20 positioned before the first polarizer 12. *Pan* therefore cannot obviate the claimed combination, because *Pan* teaches against—and therefore provides no motivation for—modifying its attenuator so that a phase retardation plate “is the first polarization-modifying component encountered by an optical signal entering through the input.” Applicant submits that *Pan* therefore cannot obviate the claim, and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claim 2-8 if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine,*

837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicant submits that claims 2-8 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 9 was rejected and obvious over *Pan*. Claim 9 recites a process combination including rotating a polarization of an optical signal using a phase retardation plate, "wherein the phase retardation plate is the first polarization-modifying component encountered by the optical signal." By analogy to the discussion above for claim 1, *Pan* does not disclose, teach or suggest a combination where the phase retardation plate is "the first polarization-modifying component encountered by the optical signal," and in fact teaches away from re-arranging its parts to arrive at the claimed combination. Applicant submits that *Pan* therefore cannot obviate the claim, and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claim 10-15 if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 9 is in condition for allowance. Applicant submits that claims 10-15 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 16 was rejected and obvious over *Pan* in view of Applicant's allegedly admitted prior art. Claim 16 recites a system combination including an optical isolator comprising a phase retardation plate positioned at the input, wherein the phase retardation

plate "is the first polarization-modifying component encountered by the optical signal." By analogy to the discussion above for claim 1, *Pan* does not disclose, teach or suggest a combination where the phase retardation plate "is the first polarization-modifying component encountered by the optical signal," and teaches away from a re-arrangement of its parts that would result in the claimed combination. Applicant's allegedly admitted prior art also does not disclose a combination including the recited limitations. Applicant therefore submits that *Pan*, even if combined with the prior art disclosure of the present application, cannot obviate the claim and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claims 17-22, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 16 is in condition for allowance. Applicant respectfully submits that claims 17-22 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant respectfully requests withdrawal of the rejections and allowance of these claims.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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Date: 3-27-06

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